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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,980	07/23/2001	Takayuki Suzuki	53375/1439	2298

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EXAMINER

LEUBECKER, JOHN P

ART UNIT PAPER NUMBER

3739

DATE MAILED: 03/01/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/909,980

Applicant(s)

SUZUKI ET AL.

Examiner

John P. Leubecker

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3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-12 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 11, 12 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 10 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 22, recitation of the first endoscope comprising an opening through which the first needle extends is indefinite as to what this is referring since Figures 28-30 do not appear to disclose such "opening" associated with the first endoscope. Furthermore, "a position on the *handle side of the distal end* of the first endoscope" is indefinite as to what position this is referring.

As to claim 23, it is unclear as to whether or not the "optical system" is referring to the observation system (claim 1).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoon (U.S. Pat. 5,993,466).

Yoon discloses a first endoscope (26), a holding device (18a) having two movable jaws (112a,114a) and passing through a first channel (22a), a first needle (180) that is movable relative to the first endoscope, a suture (184), a suture retaining device (18b) having two movable jaws (112b,114b), a knot pushing device (190) (col.17, lines 36-45), and a guide member (16) having a through hole (22b) for accommodating the suture retaining device (18b). As claim 11, needle is capable of being nearer to the handle, for instance, before the needle and endoscope are inserted into the body. As to claim 12, the jaws of holding device (18a) allows it to be "adapted" to hold any tissue and the free movement of the needle allows it to be "adapted" to be positioned anywhere.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 4, 8, 9, 11, 12 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsui et al. (U.S. Pat. 6,352,503).

If referring to Figure 11, Matsui et al. a substantially similar device as claimed (note numbered paragraph 3 of the previous Office Action, paper number 13) but fails to disclose that the holding device (47) “passes through a first channel provided in the first endoscope”. It is clear that this limitation does not encompass any channel (e.g., exterior auxiliary channel) that is not included in the existing endoscope. In this case, the holding device (47) and suture retaining device (53) of Matsui extend through external auxiliary channels (36,37, Fig.7). However, Matsui et al. teach in the embodiment shown in at least Figure 28 to place the externally retained instruments within channels formed in the endoscope itself. This would reduce the diameter of the overall device (note difference in overall diameter in Figures 7 and 28) while providing a substantially equivalent device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed at least one of the holding device (47, Fig.11) or the suture retaining device (53, Fig.11) within a channel in the endoscope itself for the reason set forth above. As to claim 8, the structure of the endoscope forming the channel accommodating the suture retaining device would meet the limitation of a guide member. As to claims 22 and 23 note channel (142, Fig.29) and optical system (113, Fig.29).

Furthermore, referring to Figures 1 and 2, Matsui et al. disclose a device including an endoscope with an internal channel (15) and two external channels (23) for accommodating treating instruments. Importantly, channel (15) and the two external channels (23) are described generically as “treatment tool insertion” channels (note col.5, lines 36-63). Although Matsui et al. provides **examples** of certain instrument combinations which can be inserted into the channels, the internal channel (15) and external channels (23) are not dedicated to any one particular treatment instrument. Therefore, even though Figure 11 exemplifies use of the device

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by showing forceps within the external channels and the needle within the internal channel, it would be well within the realm of ordinary skill in the art, and therefore obvious one of ordinary skill, to provide any arrangement of treatment tools in the channels, including providing the needle (51) within one of the external channels and the forceps (47) in the internal channel (15). This modification would not constitute an invention but merely a different intended use to meet the requirements of a certain procedure or the skill level (or preference) of the surgeon using the device. Thus obvious modification would meet the limitations of claim 1. As to claim 21, note sheath (35, Fig.5). As to claim 22, note opening (19) in Figure 2 or opening (38) of Figure 5. As to claim 23, note optical system (13, Fig.1) which can be considered "near" any of the openings.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsui et al. in view of Mangum (U.S. Pat. 5,397,326) for the reasons set forth in numbered paragraph 4 of the previous Office Action, paper number 13.

#### ***Allowable Subject Matter***

8. Claims 6, 7, 10 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-4, 6-12 and 20 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

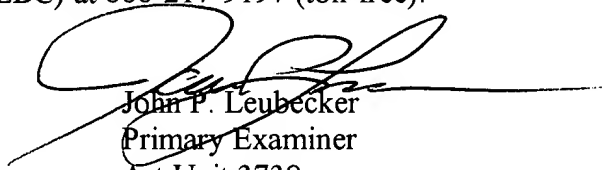
Yoon (U.S. Pat. 5,984,932)—note device including two forceps and a needle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951.

The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl